

REMARKS

Initially filed were claims 1-10. Based on the first office action dated 25 July 2001, the applicants, on 24 Jan. 2002, canceled claims 2 and 5 and amended certain others. Now in response to the final office action, the applicants cancel claims 1-10, and submit new claims 11-19. Entry is requested as none of the new claims require new searches nor introduce new matter. Support for the new claims and additional limitations can be found in the specification, and more notably on pages 14-16 and in the 178+ examples.

To cure the election/restriction problem, all claims are now directed to the same invention.

With respect to the section 112(1) issue, the applicants maintain that there is a solid basis for exclusion. The Examiner cited MPEP 2163.05 as a basis for rejection. But that section, on closer scrutiny, does not address the same situation here. That section discusses what is commonly referred to as the "omitted element" or "essential element" test. That is, the claim excludes a critical or essential feature of the invention. The reason for this rule is that where the critical feature is not even claimed, then there is no invention to claim. Here, there is no teaching of compounds that include nitrogen. In the chemical arts, it is very common to exclude certain chemical moieties and the requirement that the applicant spell out every moiety excluded is extraordinary as it would require every chemical based application to inches, feet, or miles thick. There is simply no basis for asserting that when an applicant gives a list of 180+ examples -- none of which teach a particular chemical moiety -- that the positive inclusion of a limitation that excludes that moiety is grounds for a 112(1) violation.

To show its inapplicability, ignoring prior art issues for the moment, if the applicant attempted to add a limitation that the compound included nitrogen, then there likely would be

greater force to the argument that the inventors did not “possess” nitrogen compounds because there was no positive teaching for it. Either an inventor possesses the nitrogen compound or he does not. If he would be rejected on trying to add it as he did not possess it, then a limitation that specifically excludes it must have been in his possession.

It is also well established that the specification need not explicitly teach, verbatim, the claimed limitation. That is, the precise words of the claim need not be found identically in the specification. Here, the exclusion of nitrogen is inherently in the specification as no teaching of exists in the multitude of examples. Applicants submit that the claimed exclusion of nitrogen is well described in the specification.

As the Examiner bears the burden of presenting evidence or sufficient reasons why a person of ordinary skill in the art would not recognize that the written description supports the claims, the applicants request a fuller explanation of the reasons. If the Examiner is relying on personal experience, then the applicants request the Examiner to execute the proper affidavit under 37 CFR 1.104(d)(2). The Examiner is requested to be as specific as possible so that the record is complete for appeal.

With respect to the section 102 rejections, the new claims distinguish over the prior art. The claims call for specific chemical moieties that the art does not teach.

With respect to the section 103 rejections, the claims are amended to recite pure process claims. These processes are not taught nor suggested by the prior art. Accordingly, any discussion of the claims being product-by-process claims, which applicants do not concede that they were, is now moot.

The applicants restate the arguments made in the first office action response and include them here to the extent necessary.

CONCLUSION

Applicants request prompt and favorable consideration of now pending Claims 11-19.

Respectfully submitted,

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6/24/02 *J. Ellen Hogan*
Date J. Ellen Hogan